

Application No. 09/610158
Amendment dated April 18, 2007
Reply to Office Action of March 21, 2007

Docket No.: 013212, 0137R1US
(Formerly 9203/046 RE)

REMARKS

Objection To The Prior Amendments

The Examiner objected to the Amendments to the claims submitted on 18 October 2006, 02 June 2006, 28 June 2004, and 19 June 2002 as non-compliant to the requirements of 37 CFR §§ 1.173(b), (d), and (g).

Response To Objection To The Prior Amendments

The Examiner objected to the Amendments to the claims submitted on 18 October 2006, 28 June 2004, and 19 June 2002 as non-compliant to the requirements of 37 CFR §§ 1.173(b), (d), and (g). The Examiner noted that "The amended claim must remain marked as compared to the originally patented claims." Applicants resubmit herewith the Amendment submitted on 18 October 2006 to ensure compliance with the requirements of 37 CFR §§ 1.173(b), (d), and (g) as noted by the Examiner. In particular, claim 9 is the only claim remaining in this prosecution that has been amended, and this amendment was submitted on 30 June 2000 (noted by the Examiner as "The only compliant claim amendment ..."). The details of this amendment are now displayed for claim 9 in this response, with claim 9 being noted as "Previously Presented", since these amendments were entered on 30 June 2000. Claims 1 - 8 and 15 - 29 are canceled.

Rejection Of The Claims

In the Office Action mailed 21 March 2007, the Examiner rejected claims 1 - 12 and 15 - 29 under 35 USC §251 as improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The Examiner also rejected claims 1 - 29 under 37 CFR §1.78(b) as being in conflict with claims 1 - 29 of Application No. 10/940,094.

In the Office Action mailed 21 March 2007, the Examiner rejected claims 1 - 29 under 35 USC §103(a) as being unpatentable over Chain Store Age in view of McCalley et al. (US Patent No. 5,113,496). The Examiner further rejected claims 1 - 17, 20 - 22, and 24 - 29 under 35 USC §103(a) as being unpatentable over Chain Store Age in view of the Parent patent (US Patent No. 5,774,874). The Examiner further rejected claims 1 - 17, 20 - 22, and 24 - 29 under 35 USC §103(a) as being unpatentable over Chain Store Age in view of Brumback et al. ("Electronic shopping makes the retail connection"). The Examiner further rejected claims 18, 19, and 23 under 35 USC §103(a) as being unpatentable over Chain Store Age, the Parent patent (US Patent No.

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5,774,874), Brumback et al. ("Electronic shopping makes the retail connection"), in view of McCalley et al. (US Patent No. 5,113,496). Applicants present the following arguments in support of patentability.

Response To Rejections

In the Office Action mailed 21 March 2007, the Examiner rejected claims 1 – 12 and 15 – 29 under 35 USC §251 as improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. Applicants cancel claims 1 – 8 and 15 – 29, thereby traversing this rejection with respect to these claims. With respect to claims 9 – 12 in the Preliminary Amendment dated 30 June 2000, Applicants deleted the reference to the "kiosk" from claim 9, since this structure was an unnecessary, erroneous, and gratuitous addition to the original patent. The term "kiosk" was inserted in claim 9 and is not a necessary element required to traverse any rejection of the original claims, as witnessed by claim 13 of the original patent, which fails to have such a limitation. Thus, the removal of the term "kiosk" is not improper recapture and entails removal of the entire reference to the kiosk, including the phrase "disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry" which phrase modifies the term "kiosk" since this phrase is descriptive of the kiosk.

The reissue claims are for the same invention as disclosed as being the invention in the original patent, as required by 35 U.S.C. §251, where:

- (A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. §112 first paragraph is satisfied; and
- (B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

In addition, the claims presented in the reissue application do not impermissibly recapture canceled subject matter, pursuant to the guidelines for impermissible recapture set forth by the Court of Appeals for the Federal Circuit in *Clement*, 131 F.3rd at 1468-69, 45 USPQ2d at 1164:

"The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. ... The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an Appellant surrendered particular subject

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matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection."

In particular, the rule for impermissible recapture dictates that if the claim limitation now being omitted was originally presented to make the claims allowable over a rejection made in the original application, the omitted claim limitation relates to subject matter previously surrendered by the Applicant, and impermissible recapture exists. In the original patent application, a single Office Action was issued on 20 June 1997, rejecting claims 1 - 14 under 35 U.S.C. 103(a) as being unpatentable over the publication article titled "Here Comes the (New) Bridal Registry" which appeared in the Chain Store Age Executive, October 1992, as well as by Applicants' admitted prior art discussed in the Background Of The Invention. In response to the 20 June 1997 Office Action, Applicants filed an amendment on 12 September 1997 and amended the independent claims 1, 9, and 13 to traverse the Examiner's rejection of claims 1 - 14, with claim 9 being illustrative of these amendments:

9. A system for registering items selected by a registrant from a plurality of participating merchants for subsequent communication to a prospective purchaser, the system comprising:

a gift registry kiosk disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry, the gift registry kiosk having a computer system containing identifying information about a registrant, the information for each registrant including at least one name for the registrant and a list of potential gifts which the registrant has identified;

a portable input and storage device for use by the registrant with a plurality of participating merchants, the input and storage device being capable of receiving and storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the input and storage device stores a unique identifier for the particular merchant each desired gift is from;

a transfer device connected to the computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the computer system; and

a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from.

These amendments define the fact that each merchant is assigned a unique identifier and the gift selected by the registrant is tied to a particular merchant who offers the selected gift, via the use of this unique identifier. In addition, Applicants added the limitation of a kiosk for use by the registrant to input the gift and merchant data. The arguments made by Applicants in the 12 September 1997 Amendment to present these amendments were:

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"The claims as amended are drawn to a gift registry that serves a plurality of merchants each having a store in a shopping area. Neither Applicants' admitted prior art nor the publication article is drawn to a registry serving a plurality of merchants, each merchant having a store in a shopping area. In fact, the publication article inferentially teaches away from the registry serving a number of stores in a shopping area. The registry in the publication article serves a number of stores under common ownership in a chain of stores. Typically the individual stores making up the chain of stores are located distant from one another in order to attract customers from a number of spatially distant areas, as distinct from the present invention in which the registry serves a number of different stores in a shopping area."

Nothing in these arguments refer to a "kiosk", and the arguments instead are directed to the distinguishing factor of a gift registry system that serves many merchants, each having a unique identifier, where the gift information is correlated with the selected merchant via the unique merchant identifier. Therefore, the substitution of "gift registry computer system" in claim 9 maintains the distinguishing characteristics of Applicants' invention over the cited references, which is the provision of a gift registry system for a plurality of merchants, with the registrant entering registrant gift data to indicate not only the identity of the selected gift but also the unique identity of the merchant who sells the selected gift. The more general terminology of "gift registry computer system" is supported by the disclosure of the embodiment of Figure 3 and the associated description in column 6 of the patent. Thus, the terminology "gift registry computer system" is more appropriate for use in independent claim 9 than the terminology "kiosk". In addition, the limitation "kiosk" is not addressed in Applicants' arguments in the 12 September 1997 Amendment or necessary to distinguish over the cited references as evidenced by the allowed independent claim 13 which does not contain such a limitation. Therefore, the amendments to independent claim 9 do not represent impermissible recapture of canceled subject matter.

The Examiner also rejected claims 1 - 29 under 37 CFR §1.78(b) as being in conflict with claims 1 - 29 of Application No. 10/940,094. Claims 1 - 8 and 15 - 29 are now canceled, and the Amendment dated 12 October 2005 of Application No. 10/940,094 cancelled claims 9 - 14, thereby rendering this rejection moot.

In the Office Action mailed 21 March 2007, the Examiner rejected claims 1 - 29 under 35 USC §103(a) as being unpatentable over Chain Store Age in view of McCalley et al. (US Patent No. 5,113,496). Claims 1 - 8 and 15 - 29 are canceled, rendering this rejection moot with respect to

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these claims. With respect to the remaining independent claims 9 and 13, the Examiner noted with respect thereto:

As per Claim 1, 9, 13, 15, 20, 25.

Chain Store Age discloses:

at least one data terminal comprising:

a first data entry system through which first information and inquiries about registrants in the gift registry are entered into the gift registry system, the first information for each registrant including at least the registrant's name, see page 1, lines 51-page 2 column 1, line 10;

a second data entry system capable of receiving second information, the second information including a list of potential gifts for each registrant, see page 2 column 1, lines 3-10 and lines 41-48;

a database storage system that stores and retrieves the first and second information about the registrant, see page 2, column 1, lines 6-10; and

a display system that displays the list of potential gifts for a particular registrant in response to an inquiry from a prospective purchaser, see page 2 column 3, lines 14-21.

Chain Store Age discloses the collection of SKU numbers, which can be specific to the merchant and in the case of a store brand and therefore identified with the merchant, just as the bride can scan a generic code, see page 2, column 1, lines 41-49.

Chain Store Age does not specifically disclose the unique identifier associated with the particular merchant having each of the desired gifts.

McCalley et al ('496) teaches a system that provides customers with online shopping and gift registry in the electronic mall, see column 22, lines 9-13 for the benefit of increased customer satisfaction and convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chain Store Age, if necessary, to store and display gift registry associated with different merchants, as taught by McCalley et al ('496) for the benefit of increased customer satisfaction and convenience.

Applicants have reviewed the cited references and the Examiner's comments, and provide the following arguments in support of patentability of claims 9 - 14.

Applicants' claims are drawn to a unified gift registry that serves a plurality of merchants. The gift registrant uses a portable input and storage device to identify the gifts that are to be added to the registrant's gift registry, with each item tagged also including the identification of the merchant. The gift registry enables a prospective purchaser to review all the items in the gift registry for the selected registrant, including the identification of the merchant in whose store the registrant tagged the gift. Applicants' independent claim 9 recites:

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A system for registering items selected by a registrant from a plurality of participating merchants for subsequent communication to a prospective purchaser, the system comprising:

- a gift registry computer system containing identifying information about a registrant, the information for each registrant including at least the registrant's name and a list of potential gifts which the registrant has identified;

- a portable input and storage device for use by the registrant with a plurality of participating merchants, the input and storage device being capable of receiving and storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the input and storage device stores a unique identifier for the particular merchant each desired gift is from;

- a transfer device connected to the gift registry computer system that receives the information regarding the registrant's desired gifts from the portable input and storage device and transfers the information to the gift registry computer system; and

- a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from.

The Chain Store Age Executive publication discloses a traditional merchant-exclusive gift registry system wherein a bride can scan a single store's SKU numbers into the system to generate a list of desired gifts. As noted on pages 58 and 62:

"With the new-generation system, the bride actually walks the store with a consultant to find what she wants. As she picks out items, the consultant scans them with a handheld, portable laser scanner," he says.

When the bride and the consultant return to the store's bridal registry office, the consultant downloads the scanner information by batch to the registry computer.

Also on page 62:

Moreover, when a customer buys a gift from the registry list, the system automatically removes that item from the list as soon as it is rung up at the point of sale. The on-line, real-time removal of items from the list dramatically reduces the incidence of duplicate buys, thereby also reducing returns, Asher says.

However, the Chain Store Age system does not store merchant identification information, since the gift registry is exclusively used in a single merchant's store, and does not cover multiple merchants. In fact, the entirety of the description, as highlighted by the above quotes from the article, is devoid of even a hint of multiple merchants, since the system is exclusively single merchant-centric and not extensible to multiple merchants. In fact, the concept of multiple merchants is contrary to all aspects of the teachings of the Chain Store Age article.

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The McCalley Patent teaches an interactive multimedia presentation and communications system that provides the functions and capabilities of an electronic shopping mall. In this context, a subscriber generally sees video images and hears an audio commentary about products that the subscriber has elected to view and possibly purchase. In addition to audio commentary, background music and other general information may be available. Limited forms of motion video may include short sequences of panning, zooming, and live motion. Thus, the system of the McCalley Patent permits a shopper, in the comfort of his home, to browse through an "electronic mall" of different shops, one shop at a time, to obtain detailed information on particular items, and make purchases.

As described in the McCalley Patent in column 19, lines 14 – 22:

Within the context of an electronic mall, it is useful to view each position within the mall to which a subscriber may possibly navigate, as constituting a "node" of the system. Each node has a unique appearance and structure. The appearance of the node constitutes what the subscriber is being shown and told at that point of his shopping excursion. The underlying structure of the node is represented by data which enable a particular subscriber to make particular choices.

Furthermore, in column 29, line 31 – column 30, line 2:

To complete the purchase request, session server 74 interacts with the client's network server 82 to access the client's inventory system and verify that the particular selected item is available. For purposes of this example, we assume that the merchandise item is available. The session server 74 then requests a cashier server 84 from the placement agent 72. The placement agent 72 returns the name of an available cashier server 84 to the session server 74. The session server 74 then interacts with the cashier server 84 and with a credit authorization server (not shown) which would normally be provided via the client network server 82 and the gateway 86, to authorize the sale if payment is to be made by credit card. The session server 74 proceeds to interact with the cashier server 84 to "ring up" the sale. This would normally include certain calculations such as sales tax and would include certain subscriber interactions, such as delivery information specification, which are not shown here. When the cashier server 84 is finished with the sale, it volunteers itself back to the placement agent 72. A sale confirmation script is constructed by the session server 74 and sent to the channel server 36 for transmission to the subscriber 20.

The order for the merchandise is sent to the client network server 82, and then on to the particular client through gateway 86. The channel server 36 proceeds to send the sale confirmation script, and accompanying audio or video images to the subscriber presentation player 54 via the multiplexer/modulator 81 and transmitter 83. Meanwhile, the session server 74 has pre-fetched the script shell from data services 79 for each possible choice that the subscriber is offered in the sale.

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confirmation presentation. The subscriber 20 makes a choice from the menu presented (such as suggestions for synergistic sales). His choice reaches the session server 74 via the voice network server 70. Session server 74 proceeds to update the script shell which has been pre-fetched, with the information representing the subscriber's choice, and sends it to the channel server 36.

Therefore, the system of the McCalley Patent operates seriatim to enable a customer to initiate a shopping session and purchase goods from each store in the electronic mall, with the transaction being completed before the customer leaves the store. Again, as with the Chain Store Age publication, the various stores are each independently operational, and the system of the McCalley Patent simply provides the customer with a single gateway by which to browse the various stores in the electronic mall on a seriatim basis, with each store maintaining their own inventory information, and wherein "Each node has a unique appearance and structure. The appearance of the node constitutes what the subscriber is being shown and told at that point of his shopping excursion." Thus, there is no suggestion in the McCalley Patent to provide a unified database of gift registry information, where the data entries are distinguished by a "unique identifier associated with the particular merchant having each of the desired gifts," as is specifically recited in Applicants' independent claims. Thus, the McCalley Patent is devoid of a gift registry across the various merchants, since "Within the context of an electronic mall, it is useful to view each position within the mall to which a subscriber may possibly navigate, as constituting a 'node' of the system. Each node has a unique appearance and structure." as is noted in the McCalley Patent. Thus, the McCalley Patent is a gateway that enables the customer to access a plurality of individual, independent stores, execute a complete shopping session in each store visited, and exit the store with the purchases completed before moving to the next store in the mall. There is no gift registry that links information among the stores in a common database using a "unique identifier associated with the particular merchant having each of the desired gifts," as is specifically recited in Applicants' independent claims.

Applicants disagree with the Examiner's 35 U.S.C. §103(a) rejection of claims 9 - 14 as being unpatentable because the Examiner failed to establish a prima facie case of obviousness of Applicants' claimed invention for the following two reasons:

A. The Examiner has failed to cite and apply prior art which contain all of the claimed elements or limitations of Applicants' claimed invention.

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B. The Examiner has failed to identify any motivation or suggestion to combine elements from the prior art to render the claimed invention obvious, and instead has relied upon hindsight to reconstruct Applicants' claimed invention from the prior art.

None of the prior art relied upon by the Examiner in the rejection of claims 9 - 14 contains the following elements or limitations recited in Applicants' independent claims:

- 1.) a portable input and storage device for use by the registrant with a plurality of participating merchants, the input and storage device being capable of receiving and storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the input and storage device stores a unique identifier for the particular merchant each desired gift is from;
- 2.) a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from.

Furthermore, the MPEP and case law have established a need to show a motivation to combine the references in a 35 U.S.C. §103 obviousness rejection:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teaching found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Frisch*, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Examiner has not provided a factual basis for his suggested combination and admits that Chain Store Age fails to show or suggest a multi-merchant gift registry system. The Examiner also fails to show where the McCalley Patent teaches a gift registry that operates uniformly across multiple merchants, but simply notes that the modification of both references in a manner as taught exclusively by Applicants would produce a system that has improved performance "for the benefit of increased customer satisfaction and convenience." In fact, the combination suggested by the Examiner is contrary to the teachings of both references. Therefore, the basis for this combination is impermissible hindsight engineering:

A rejection based on §103 clearly must rest on a factual basis, without hindsight reconstruction of Applicant's system of the prior art. In making this evaluation, all the facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not because it may doubt that the invention is

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patentable resort to speculation, unfounded assumptions or hindsight reconstruction to supply its factual basis. *In re Warner*, 154 USPQ 173 (CCPA 1967).

Therefore, Applicants believe that claims 9 – 14 are allowable under 35 U.S.C. §103(a) over the cited Chain Store Age and McCalley Patent, since neither of these references show or suggest Applicants' claimed "a portable input and storage device for use by the registrant with a plurality of participating merchants, the input and storage device being capable of receiving and storing information regarding the registrant's desired gifts including the merchant each desired gift is from, wherein the input and storage device stores a unique identifier for the particular merchant each desired gift is from" or Applicants' claimed "a prospective purchaser interface device that allows a prospective purchaser to view a list of the goods desired by the registrant wherein the list includes information about the particular merchant each gift is from."

The Examiner further rejected claims 1 – 17, 20 – 22, and 24 – 29 under 35 USC §103(a) as being unpatentable over Chain Store Age in view of the Parent patent (US Patent No. 5,774,874). These claims were canceled, rendering this rejection moot.

The Examiner further rejected claims 1 – 17, 20 – 22, and 24 – 29 under 35 USC §103(a) as being unpatentable over Chain Store Age in view of Brumback et al. ("Electronic shopping makes the retail connection"). These claims were canceled, rendering this rejection moot.

The Examiner further rejected claims 18, 19, and 23 under 35 USC §103(a) as being unpatentable over Chain Store Age, the Parent patent (US Patent No. 5,774,874), Brumback et al. ("Electronic shopping makes the retail connection"), in view of McCalley et al. (US Patent No. 5,113,496). These claims were canceled, rendering this rejection moot.

Summary

Applicants believe that the technical objections to the priorly filed Amendments have been addressed and overcome. In addition, Applicants believe that claims 9 – 14 are allowable over the cited references for the reasons noted above.

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance. Applicants believe no fee is due with this response.

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P. 16

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However, if a fee is due, please charge our Deposit Account No. 50-1848, under Order No. 013212.0137R1US from which the undersigned is authorized to draw.

Respectfully submitted,
PATTON BOGGS LLP

Dated: 19 APRIL 2007

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